

Docket No. F-7872

Ser. No. 10/603,316

REMARKS

Claims 1-4 remain pending in this application. Claims 1-4 are rejected. Claim 1 is amended to further clarify the invention and to incorporate a portion of the subject matter of claims 3 and 4. Claims 3 and 4 are amended to omit matter incorporated into claim 1.

CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claim 1 is rejected as obvious over the Hsu reference in view of the Usui '650 reference and further in view of the Blythe reference under 35 U.S.C. §103(a). Claims 2-4 are rejected as obvious over the Hsu reference in view of the Usui '650 and Blythe references and further in view of the Salatino reference under 35 U.S.C. §103(a). The applicant herein respectfully traverses this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

It is respectfully submitted that a *prima facie* case of obviousness cannot be established in rejection of amended claims 1-4 and was not established in rejection of claims 3 and 4. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either

Docket No. F-7872

Ser. No. 10/603,316

in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

Claim 1 to the present invention has incorporated in it features of claim 3 and 4 including:

a chamber having an opening, opposing sides at the opening and a planar bottom surface extending from the sides and across a bottom edge of the opening with a surface of the fingerprint reader disposed in and level with the planar bottom surface, the chamber being configured aligned about the fingerprint reader to receive a finger through the opening in an insertion orientation guided by the opening and the chamber to align the finger with the fingerprint reader[.]

The present invention of claim 1 has clear structural distinction from each of the cited references in that the chamber is configured to align the finger with the fingerprint reader and in the features of "a surface of the fingerprint reader disposed in and level with the bottom surface."

Docket No. F-7872

Ser. No. 10/603,316

In contrast, Usui has a detection aperture 11 disposed sunken into a bottom surface of the chamber. It is this aperture which the user must feel out in order to guide the finger into the proper position for reading. The detection aperture 11, is a small portion of the bottom of the chamber and as such the chamber cannot effectively guide the finger because of the excess space and the walls not being aligned about the fingerprint reader. The user must shift their finger around to find the aperture. This is why the aperture 11 forms a step in the bottom surface of the chamber so that a user may feel for the correct position by locating the stepped sides of the aperture. Thus, the finger is not aligned by the chamber with the detection aperture 11 when inserted in the chamber. Therefore, the chamber of Usui does not teach one of a "the chamber being configured aligned about the fingerprint reader to receive a finger through the opening in an insertion orientation guided by the opening and the chamber to align the finger with the fingerprint reader."

In view of the chamber of the Usui reference not being aligned with the fingerprint reader, the detection aperture 11 of Usui forms a recess which has a bottom, distinct from the surface at the sides of the opening, which extends to the front of the opening. Thus, there is no teaching suggesting "a planar bottom surface extending from the sides and across a bottom edge of the opening with a surface of the fingerprint reader disposed in and level with the planar bottom

Docket No. F-7872

Ser. No. 10/603,316

surface." The bottom surface of the recess of the Usui reference extends to a front edge of the opening, interrupting the bottom surface of the chamber from extending across a front edge of the opening from the sides of the opening. This construction creates a recess opening to a front edge, and thereby forming an indentation in the front edge is necessary to assist in aligning one's finger. Thus, the overall construction of the Usui device is markedly different from the invention of claim 1 and the reference cannot teach all the claimed features of the present invention.

With regard to the inwardly opening door, the Examiner looks far afield to a construction used in a pay phone which has nothing to do with fingerprint reading devices, or a door locking mechanism.

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) -- in other words, common sense -- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

In re Oetiker, 24 USPQ2d 1443 (CAFC 1992). It is respectfully submitted that the construction of pay phones lacks any relation to fingerprint readers or locking

Docket No. F-7872

Ser. No. 10/603,316

mechanisms for doors. As such, this not a relevant field of the present invention. Nothing in the other references would direct one to pay phone construction, and certainly nothing in the Blythe reference relates to fingerprint reading mechanisms. Accordingly, suggestion to make the proposed combination can only have been based upon the applicant's own disclosure. "It is improper as a matter of law to use the claims presented as a blueprint to combine prior art references." *Ashland oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657, 667 (CAFC 1985). In the present rejection, it appears the Examiner has recognized a similarity in construction of the present invention to pay phones and chosen to seek out a pay phone reference to build a case of obviousness. While such recognition in hindsight is possible after viewing the present disclosure, it is hardly suggested by the references.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of claims 1-4 and their allowance are respectfully requested.

If there is any fee due, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

Docket No. F-7872

Ser. No. 10/603,316

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. B. Hamburg
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

by and,

By H. F. Ruschmann
Herbert F. Ruschmann
Reg. No. 35,341
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

REST AVAILABLE COPY